Docket No.: PF-0066-4 DIV

REMARKS

Claims 3 and 6 have been amended herein to fix minor grammatical errors in the claim language. Entry of these amendments is respectfully requested.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-11 and 14) drawn to antibodies which bind to SCAH-2 and methods of making said antibodies.

Group II (claims 12, 13, 15, 16, and 18-20) drawn to diagnostic tests for diseases or conditions associated with SCAH-2 and methods of treating cancer, all methods comprising contacting or administering the antibody of Group I.

Group III (claim 17) drawn to a method of purifying the protein of SEQ ID NO:2 comprising contacting with the antibody of Group I.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-11 and 14. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants also submit that the inventions encompassed by Group II (claims 12, 13, 15, 16, and 18-20) and Group III (claim 17) are drawn to methods of use of the antibodies of Group I, and should be examined together. These method claims recite a product (i.e., an antibody), which is of the same scope as the claimed antibodies being searched by the Examiner. Therefore, it would not be an undue burden on the Examiner to examine these method claims since the searches for the claimed antibodies and these method claims would substantially overlap.

Additionally, the method claims of Group II and Group III are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows.

> Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . The claims to the nonelected invention

> will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the entirety of Applicants' claims.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
INCYTE CORPORATION

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 3 and 6 have been amended as follows:

3. (Once Amended.) A method of preparing a polyclonal antibody with the specificity of the antibody of claim 1 comprising:

a) immunizing an animal with the polypeptide of SEQ ID NO:2 or an immunogenic fragment of at least 10 amino acid residues thereof under conditions to elicit an antibody response;

b) isolating animal antibodies; and

c) screening the isolated antibodies with the polypeptide thereby identifying a polyclonal antibody which binds specifically to the polypeptide of SEQ ID NO:2.

6. (Once Amended.) A method of making a monoclonal antibody with the specificity of the antibody of claim 1 comprising:

a) immunizing an animal with the polypeptide of SEQ ID NO:2 or an immunogenic fragment of at least 10 amino acid residues thereof under conditions to elicit an antibody response;

b) isolating antibody producing cells from the animal;

c) fusing the antibody producing cells with immortalized cells in culture to form monoclonal antibody-producing hybridoma cells;

d) culturing the hybridoma cells; and

e) isolating from the culture a monoclonal antibody [antibodies] which binds specifically to the polypeptide of SEQ ID NO:2.